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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/809,340	05/06/97	PADOVANI	P-2239-PT15

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IM22/1121

MACKEY, J.	EXAMINER
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ART UNIT 1722	PAPER NUMBER
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DATE MAILED: 11/21/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/809,340

Applicant(s)

PADOVANI

Examiner

Jam s Mackey

Group Art Unit

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☒ Responsive to communication(s) filed on Sep 5, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1, 3-30, 43, and 44 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 3-30, 43, and 44 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

Note that the declaration filed on Sept. 15, 2000, does not claim priority to PCT International Application No. PCT/EP95/03451 filed on 01 September 1995 (which should be listed in section (c) of the declaration, as in the originally filed declaration), and therefore the declaration does not properly claim priority to the Italian Patent Application VR94A000082 filed on 14 September 1994.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claim 1 is rejected under the judicially created doctrine of double patenting over claims 1 and 2 of U. S. Patent No. 6,022,208 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: an apparatus for picking up and transferring cup-shaped objects from a female die in a thermoforming machine.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-30, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application GB 2,263,660 taken together with International Application Publication WO94/15863 (Figures 11-15).

GB '660 teaches the thermoforming apparatus substantially as claimed, including extraction heads PA, 26, 27 for extracting thermoformed articles from the female die and

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transferring the articles to conveying templates on a conveyor (see especially Figures 14-23 and 32). GB '660 further teaches that the extraction head and the conveying template have receiving seats for the thermoformed articles, but does not teach that the receiving seat is defined by two annular surfaces defining an annular shoulder therebetween. WO94/15863 teaches a thermoforming apparatus including an extraction head having receiving seats defined by two annular surfaces defining an annular shoulder therebetween (the receiving seat reading on the retention surface defined by at least a portion of a wall of a cavity in an element, the cavity communicating with at least one exterior surface of the element and having an interior dimension which is smallest in a region remote from said exterior surface to define a shoulder thereat, as claimed in claim 43, the shoulder including a slightly undercut internal angle of incidence as claimed in claim 44). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify GB '660 by providing the receiving seats of both the extraction head and the conveying template as the receiving seat having an annular shoulder as disclosed in WO94/15863, in order to more securely attach the thermoformed articles to the extraction head and the conveying template. It would have been further obvious to a skilled artisan to have provided the conveyors of GB '660 as conventional chain conveyors (note Fig. 22), and obvious to have provided the receiving seats with either deformable collar or ratchets/arrests, as taught in WO94/15863 (see Figs. 2-3 and 5-10), in order to more accurately locate and retain the thermoformed articles; note also the ratchets/arrests taught in GB '660 at Figs. 24, 26 and 28.

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6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over GB '660 taken together with WO94/15863, as applied to claims 4-30, 43 and 44 above, and further in view of Beyer-Olsen et al. (U.S. Patent 3,966,386).

GB '660 does not teach a carousel conveyor having a plurality of arms. Beyer-Olsen et al. teach an apparatus for removing molded articles from a molding device comprising a carousel conveyor having a plurality of arms, each arm being provided with a means for gripping the molded article and moving said article to another location. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify GB '660 by providing the conveyor as a carousel conveyor, as disclosed in Beyer-Olsen et al., in order to facilitate the conveying of the molded articles.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Padovani (U.S. Patent 4,560,339; Figure 3) in view of German Patent 3,928,301.

Padovani '339 teaches a thermoforming apparatus comprising sets of male/female dies (as clearly shown in Figure 1), extraction pick-up means 12 including a plate member having a recess for engaging with the thermoformed articles for withdrawing the articles and transferring the articles to a receiving conveyor 42 (as clearly shown in Figure 3). Padovani '339 does not teach the extraction pick-up means including a receiving hole defined by two annular surfaces reamed in opposite directions and defining between them an equatorial shoulder for engaging and positioning the article. German '301 teaches a thermoforming apparatus including an extraction pick-up means comprising a plate member having receiving holes each defined by two annular

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countersunk surfaces defining an equatorial shoulder therebetween (as clearly shown in Figure 1) for engaging and positioning the article. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Padovani '339 by providing the extraction pick-up means as the extraction pick-up means disclosed in German '301 including receiving holes each having an interior shoulder, in order to more securely engage with the articles to be removed from the thermoforming machine. While German '301 teaches plural countersunk engagement tabs 9 (as shown in Figure 2), it would have been obvious to a skilled artisan to have provided the countersunk engagement surface around the entire perimeter of the receiving hole (thereby defining two countersunk "annular" surfaces) in order to securely engage the entire rim of the object being held; note also that Padovani '339 teaches that the engagement surface in the extraction pick-up means engages the entire rim of the object being held.

8. Applicant's arguments filed Sept. 5, 2000, have been fully considered but they are not persuasive.

Applicant's new declaration (making the instant application a CIP of Application S.N. 08/481,458) is sufficient to obviate the rejection of claim 1 over GB '660 taken together with WO94/15863, since claim 1 is fully supported by the original disclosure of S.N. 08/481,458. However, note that none of the other pending claims is fully supported by the original disclosure of S.N. 08/481,458, and therefore none of the other pending claims are entitled to the benefit of the filing date of S.N. 08/481,458.

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Applicant argues that GB '660 and WO94/15863 do not suggest receiving holes in the conveying template, the receiving holes having a retention surface defined by at least a portion of a wall of a cavity in an element, the cavity communicating with at least one exterior surface of the element and having an interior dimension which is smallest in a region remote from said exterior surface to define a shoulder thereat, as claimed in claim 43, the shoulder including a slightly undercut internal angle of incidence as claimed in claim 44. However, the Examiner contends that a skilled artisan would have been motivated to provide both the extraction pick-up means and the conveying templates of GB '660 with retention surfaces as taught in WO94/15863 in order to more securely hold the rims of the objects being held and transferred.

Applicant argues that neither Padovani '339 nor German '301 disclose a receiving hole defined by two annular surfaces reamed in opposite directions (i.e., two countersunk annular surfaces) to define an equatorial shoulder therebetween. However, the Examiner contends that German '301 teaches countersunk engagement surfaces defining an equatorial shoulder, and it would have been obvious to have provided such countersunk engagement surfaces defining an equatorial shoulder in the extraction pick-up plate of Padovani '339, with it being further obvious to have provided the engagement surfaces around the entire receiving hole in order to engage the entire perimeter of the rim of the object being held.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is (703) 308-1195. The examiner can normally be reached on Monday-Friday from 8:30AM to 6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (703) 305-4251. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651. Any inquiry relating to the contents or papers filed in this application, other than issues of substance requiring the attention of the Examiner, should be directed to the Customer Service Office, Technology Center 1700, whose telephone number is (703) 306-5665.

MACKEY/jpm
November 20, 2000


JAMES MACKEY
PRIMARY EXAMINER
ART UNIT 1722

11/20/00